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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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11/21/2000

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06/28/2004

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EXAMINER

KIM, AHSHIK

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/717,841 | <b>Applicant(s)</b><br>DANIELSON ET AL. |  |
|                              | <b>Examiner</b><br>Ahshik Kim        | <b>Art Unit</b><br>2876                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 16-44 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,4 and 30-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-29,37-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Amendment*

1. Receipt is acknowledged of the amendment filed on March 24, 2004. In the amendment  
5 claims 1, 2, 4, and 30-36 are withdrawn as being drawn to a non-elected group, and claims 16  
and 23 were amended. Currently, claims 16-29, and 37-44 remain for examination.

### *Obviousness-Type Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in  
10 public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise  
extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple  
assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759  
F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA  
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163  
15 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome  
an actual or provisional rejection based on a nonstatutory double patenting ground provided the  
conflicting application or patent is shown to be commonly owned with this application. See 37  
CFR 1.130(b).

20 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer.  
A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 16-29 and 37-44 are rejected under the judicially created doctrine of obviousness-  
type double patenting as being unpatentable over claims 1-72 of US Patent 6,149,062 to  
25 Danielson et al. (hereinafter '062 patent).

Although the conflicting claims are not identical, it is the Examiner's view that they are  
not patentably distinct from each other.

In claim 16 of the instant application, the Applicant claims "A data processing system,  
comprising: (a) a data processing assembly including an interface unit; and (b) a detachable  
30 reader unit detachably assembled with said interface unit; (c) said detachable reader unit

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comprising a non-contact data reader to read data disposed in non-contact relationship to said reader unit; wherein said data processing assembly is portable and wherein said detachable reader unit does not extend said data processing assembly's width or length when attached thereto." Claim 1 of '062 patent recites "A hand-held data collection system, comprising: (a) a

5 base unit, of size to be held in one hand during data collection, said base unit comprising a user interface; and b) a detachable reader unit, capable of being coupled with said base unit, said reader unit comprising a non-contact data reader reading data disposed in non-contacting relationship to said reader unit, said reader unit further comprising an energy source." They essentially claim virtually identical apparatus – a hand-held data collection system. Examiner

10 carefully considered amended claim 16 in view of the '062 patent. Although claim 16 of the instant application specifically describes size aspect of the data processing assembly in relation to the detachable data reader, it is obvious to one ordinary skill in the art to design the assembly so that the assembly as a whole would have a shape of one unit. Moreover, it is the Examiner's view that size and/or shape limitation alone would not be considered a patentable element unless

15 Applicant discloses why the amended limitation is patentable. For example, Applicant is respectfully requested to point out in the specification (particularly in summary of invention section) where such limitation is disclosed. An attempt to merely overcome the cited references would be a hindsight approach by the Applicant.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to

20 overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

5 A person shall be entitled to a patent unless –

10 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 16-29 and 37-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Sherman et al. (US 5,347,115, hereinafter “Sherman”).

15 Re claims 16, 20-23, 27-30, and 34-41, Sherman teaches a portable data collection apparatus (see figure 1 and 4) comprising a hand-held scanner 70 and a cradle member 56 (col. 4, lines 48+; col. 6, lines 25+). As shown generally in figures 1-6, the data processing assembly (comprising a data collector and a base unit) are similar in size, and the reader does not extend the cradle.

20 Re claims 17, 24, and 31, the data collector 70 is comprised of a display 28 and a keyboard 29 (col. 4, lines 62+).

Re claims 18, 19, 25, 26, 32, 33, 43, and 44, the scanner, reading barcodes, generates and a light beam (col. 5, lines 34-48).

25 Re claim 42, the system or the component can be powered by batteries 65 (col. 6, lines 53+).

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***Response to Remarks***

6. Applicant's remarks filed on March 24, 2004 have been carefully considered. Examiner appreciates Applicant's effort to advance prosecution of application. Examiner also reviewed previous Office Action(s). In view of the above, this Office Action is made non-final.

5

***Conclusion***

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hagerty (US 5,576,530); Hanson et al. (US 5,625,180) disclose a data collection system comprising scanner and interface. Applicant is respectfully suggested to carefully review these references.

10

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

20

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

30



Ahshik Kim  
Patent Examiner  
Art Unit 2876

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June 22, 2004